

REMARKS

Claims 1-20 are pending in this application. Claims 4-15 and 17-20 have been indicated as being allowable over the prior art of record, but stand objected to as being dependent upon a rejected base claim. Claims 1-3 and 16 stand rejected and are at issue herein. Reconsideration of claims 1-20 and indication of their allowability in view of the foregoing amendments and following remarks are respectfully solicited.

The Examiner has rejected claims 1-4 and 16 under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Lindner (DT 23 56 500) and Thrush (U.S. 4,495,387). The applicant has thoroughly considered each of these references and the Examiner's rational for combination thereof, but must respectfully traverse this ground of rejection. Reconsideration of claims 1-4 and 16 in view of the following remarks and indication of the allowability of these claims at an early date are respectfully solicited.

The Examiner is correct that paragraphs 0003 to 0006 describe the use of an infinite switching type energy regulator and an additional, separate toggle switch to select between 120 volt and 240 volt inputs on high end electric ranges. The Examiner is also correct that the basic abstract of Lindner teaches a voltage selection switch utilizing a single rotatable shaft for selecting between voltages. Finally, the Examiner is correct that Thrush '387 teaches the use of a single rotatable shaft to actuate a plurality of different switches via a cam stack. However, as will be discussed more fully below, the applicant respectfully submits that a *prima facie* case of obviousness has not been made out because there is no suggestion or motivation for supporting the proposed combination of references, and there is no reasonable expectation of the success from the combination as proposed by the Examiner.

It is axiomatic that in order to support a combination of references there must be some suggestion or motivation to support the combination. In setting forth the suggestion or motivation, conclusory statements cannot be relied upon. Instead, the rational for combining the references must be set forth. See *In Re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (explaining that the Examiner can satisfy this burden only by relying on objective evidence and making specific factual findings with respect to the motivation to combine references). Further, the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In Re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). See also MPEP §2143.01.

In this case the Examiner has indicated that the suggestion or motivation to combine these three references is "to reduce the number of external control elements on the appliance." However, the applicant respectfully submits that this is a mere conclusory statement that simply parrots the applicant's own statement as to his motivation for making the invention, a motivation which appears nowhere in the prior art. Indeed, as described in the cited paragraphs of the background of the instant application, the high-end, i.e., most expensive, electric ranges utilize a separate toggle switch for the voltage selection. The manufacturers of such high-end electric ranges apparently do not see the inclusion of a separate toggle switch as a problem that needs overcoming. Instead, it is the inventor who believes that a reduction in the number of external control elements is desirable.

As stated by the applicant in paragraph 0009, "there is a need for a combined selector switch and infinite switch energy regulator that provides a single actuation mechanism for a user, thereby avoiding the increased space on the range top required by the use of a separate toggle switch and a separate infinite switch energy regulator actuator, and improving the intuitive control of the infinite switch at different voltages." However, this statement of motivation may not be used against the applicant to reject the claims to his own invention. The admitted prior art in 0003 to paragraph 0006 of the present application clearly does not provide any indication that the manufacturers of the prior high-end electric ranges believe that their design presented any problems.

Similarly, the rotary voltage selection switch of Lindner does not teach or suggest that its mechanism could be combined for any purpose of reducing the number of user inputs on an electric range. Indeed, the combination of the high-end electric range described in the background of the application section and Lindner would result simply in the replacement of the toggle switch with the rotary actuator of Lindner. However, this combination would still result in two separate user inputs, one for the infinite switch regulator and one for the voltage selector.

This result is not changed by the inclusion of Thrush '387 which utilizes a cam stack to actuate various switches at different rotational angles. Indeed, the existence of rotary actuated cam stacks for the purpose of switching multiple different switches has been known for many many years, and long before the high-end electric ranges chose to utilize a separate toggle switch from the infinite switch regulator on their high-end electric ranges. Therefore,

the applicant respectfully submits that Thrush '387 does not provide any suggestion or motivation that would cause one of ordinary skill in the art at the time the invention was made to combine the separate functionality of the voltage selector switch with the infinite switch regulator on an electric range, particularly in view of the fact that the high-end ranges that include both types of mechanisms do not combine them.

Indeed, the rotary selector switch of Thrush '387 does not recommend or suggest a reduction in the number of user inputs, but instead is directed at providing a highly reliable and long lived, cost effective switch without the need for terminals fastened to the wire ends to be mechanically and electrically connected to the switch. That is, Thrush '387 recognizes that multi-circuit electric switches that contain a plurality of switching elements actuated by a single control knob rotated by the user exists on domestic appliances such as clothes, washers and dryers, cooking ranges, and dishwashers. Thrush '387, column 1, lines 5-13. To the applicant's knowledge, such multi-circuit electric switches that are utilized on electric ranges, for example, to provide a baking mode, and broiling mode, a self-cleaning mode, etc., were never provided as separate user outputs that were then combined in the multi-circuit switches. Indeed, the high-end electric ranges described in the background of the instant application also includes such multi-circuit electric switches for providing this same functionality, but yet still provided a separate toggle switch for the voltage selection as described in this background section.

Therefore, the applicant respectfully submits that there is no suggestion or motivation to support the proposed combination of these references. Indeed, the statement set forth in the Office Action merely parrots the suggestion and motivation that drove the inventor to come up with his invention, which statement cannot be used to reject the claims of this application. Reconsideration of this ground of rejection and indication of the allowability of claims 1-3 and 16 at an early date are therefore respectfully solicited.

The applicant also respectfully submits that there is no likelihood of success from the proposed combination. Specifically, the rotary voltage selector of Lindner requires that the operating spindle, which may be an integral part of the actuator knob, be free to turn through a hole in the plate. However, with the rotary selector switch of Thrush '387, the operating spindle is not free to turn relative to the wiper contact plate. Quite to the contrary, the rotary selector switch of Thrush '387 requires that the selector shaft actually carry and rotate the cam stack, not freely rotate with respect thereto. Further, the rotary selector switch of Thrush

'387 requires a cover member 10 be utilized in the assembly, the cover including an aperture 14 that must act as a bushing like bearing surface to rotatably support the shaft. Such a requirement precludes the ability for the shaft to be an integral part of the actuator knob as required by the rotary voltage selector switch of Lindner. As such, the applicant respectfully submits that there is no likelihood of success in this proposed combination. Therefore, the applicant respectfully submits that claims 1-3 and 16 are also not rendered obvious for this additional reason. Reconsideration of this ground of rejection and indication of the allowability of claims 1-3 and 16 at an early date are therefore respectfully solicited.

The Examiner has objected to claims 5-15 and 17-20 as being dependant upon a rejected base claim, but has indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While the applicant respectfully submits that such amendment is not required in view of the traversal of the ground of rejection of independent claims 1 and 16 from which these claims ultimately depend, in the interest of expediency, and for no reason related to patentability of these claims, the applicant has adopted the Examiner's suggestion as indicated in the amendments above. However, the applicant wishes to state on the record that such amendments are merely being made as a matter of form in the interest of expediency, and that these claims do not differ in scope from that of the originally filed claims. Therefore, the applicant respectfully submits that he is entitled to the full scope of these claims, including equivalents as if these claims had been originally filed in this form.

In view of the above amendments, reconsideration of this ground of objection and indication of the allowability of claims 4-15 and 17-20 at an early date are respectfully solicited.

The applicant respectfully submits that claims 1-20 stand in condition for allowance. Reconsideration of claims 1-20 and indication of their allowability in view of the foregoing amendments and remarks and indication of their allowability at an early date are respectfully solicited.

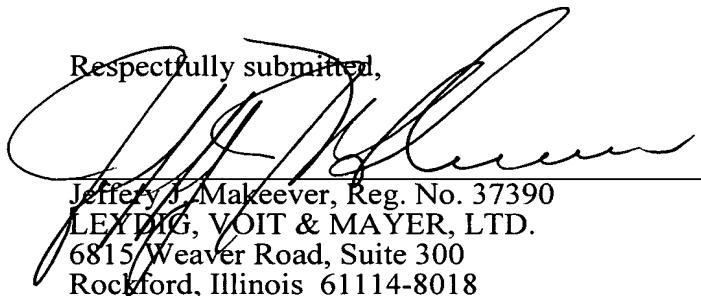
The applicant has included herewith a copy of an Information Disclosure Statement and PTO 1449 form as attachment 1, which was originally filed in this application on January 6, 2004. As was the practice at the time, the applicant also included copies of each of the thirteen (13) patents cited on the PTO 1449 form. Receipt of this Information Disclosure

In re Appln. Of: Charles A. Garris III
Application No.: 10/058,350

Statement was confirmed by mailroom stamp on January 8, 2004, on the return receipt postcard, a copy of which is included herewith as attachment 2. However, the above-referenced Office Action did not include a copy of the PTO 1449 form including indication that the Examiner has considered the references submitted therewith. A check of the on-line PAIR system does not reveal that this Information Disclosure Statement has ever been matched with this application, despite the fact that it was filed approximately ten (10) months prior to the issuance of the above-identified Office Action. However, since this Information Disclosure Statement was properly filed prior to this application being taken up for examination, the applicant respectfully submits that this Information Disclosure Statement must be considered, as a matter of right, in this application without fee. As current practice does not require the submission of U.S. patents, no such copy has been included herewith. However, should the Office require such copies the applicant would be happy to oblige.

If the Examiner believes that a telephonic conversation will aid in the resolution of any issues not resolved therein, including the issue of the Information Disclosure Statement originally filed in January of this year, the Examiner is invited to contact the applicant's attorney at the telephone number listed below.

Respectfully submitted,



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